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In the Supreme Court of the United States

OCTOBER TERM, 1945.

No. .....

THE UNION METAL MANUFACTURING COMPANY,
and
EDMUND W. RIEMENSCHNEIDER, and
MABEL ST. ELMO RASTETTER,
Executrix of HARRY O. RASTETTER, Deceased,
Petitioners,

vs.

CASPER W. OOMS,
as Commissioner of Patents,
Respondent.

PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE DISTRICT OF COLUMBIA

To the Honorable the Chief Justice and Associate Justices of the Supreme Court of the United States:

Your Petitioners, The Union Metal Manufacturing Company, *et al.*, respectfully Pray that a Writ of Certiorari issue to the United States Court of Appeals for the District of Columbia to review the Judgment of that Court entered on April 15, 1946, in the above entitled case (R. 161),* affirming the dismissal of Petitioners' complaint by the United States District Court for the District of Columbia.

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* Refers to the Certified Joint Appendix printed by the Clerk of the Court of Appeals for the District of Columbia, submitted herewith, as supplemented by the Clerk of this Court.

A transcript of the Record in the case, including the proceedings in said Court of Appeals, is furnished herewith, in accordance with Rule 38 of this Court.

Summary and Short Statement of the Matter Involved

On August 4, 1941 Riemenschneider and Rastetter filed an application for Letters Patent of the United States in the United States Patent Office for certain improvements in Radio Antenna Tower, and assigned the same to The Union Metal Manufacturing Company, which application was designated as Serial No. 405,378 and contained claims 14 and 15 for a new and useful Compression Member which were sub-combinations of larger combination claims for a Radio Antenna Tower (R. 40, 43, 44).

The Radio Antenna Tower claims were duly allowed as patentable (R. 52, 55) and have since been granted to your Petitioners in Patent No. 2,401,799* (Official Gazette, U. S. Pat. Off., June 11, 1946, Page 244); but the Compression Member claims 14 and 15 amended as claims 16 and 17 (R. 52) for sub-combinations of the allowed claims were finally rejected by the Examiner on October 14, 1942 (R. 55), in the original application.

On December 10, 1943 Riemenschneider and Rastetter filed a divisional application for the new and useful Compression Member and assigned the same to The Union Metal Manufacturing Company, which application was designated as Serial No. 513,730, and contained two claims

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* **Allowed Claim** 1 in Patent No. 2,401,799 is as follows—

"1. An articulated radio antenna tower including a plurality of tubular compression members supported end to end upon one another, means providing flexible joints between said members, each of said members consisting of tubular sections joined together in end-to-end abutment and having its greatest lateral dimension at its central portion and tapering gradually therefrom to its ends, and guy wires attached under tension to the upper end of each said member."

1 and 2 corresponding in substance to the claims 14 and 15 presented in the parent application (R. 104, 109).

On March 24, 1944, the Examiner finally rejected the two pending claims† as being unpatentable over various combinations of sundry prior patents, none of which disclosed the structures defined by said claims or suggested the benefits resulting therefrom, and none of them anticipated the pending claims (R. 119, 120).

On March 29, 1944, your Petitioners filed an Appeal to the Board of Appeals in the Patent Office (R. 121), and on May 20, 1944 the Examiner's decision was affirmed by the Board (R. 154), in spite of the admissions of the Examiner and the Board set forth in page 19, *infra.*

Thereafter, on November 8, 1944, your Petitioners duly filed their Complaint in the United States District Court for the District of Columbia (R. 2), praying for a declaration and a judgment authorizing and directing the Commissioner of Patents to issue a patent to your Petitioners, as provided in Sec. 4915 R. S., 35 U. S. C. 63.

On June 4, 1945, the District Court entered a few Findings of Fact and Conclusions of Law based solely on prior art patents, and a Judgment dismissing the Complaint; without rendering any Opinion whatever, and without entering any Findings or Conclusions on the Affidavits submitted in the Patent Office or on the Additional Proofs presented at the Trial by documentary evidence and the unusual testimony of numerous notable and disinterested witnesses (R. 13, 15, 16).

On August 27, 1945, the Honorable Casper W. Ooms, Commissioner of Patents, was substituted as Defendant for

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† **Refused Claim 1,** rejected in Ser. No. 513,730, is as follows—

"1. A longitudinal compression member having equal strength in all lateral directions comprising two elongated frustro-conical tubes in substantially straight axial alignment throughout their length with their large ends joined in abutment, and means at each end of said member for receiving and transmitting compressive forces longitudinally through said member." (R. 109).

the Honorable Conway P. Coe, formerly Commissioner of Patents (R. 16); and on the same day a Notice of Appeal to the United States Court of Appeals for the District of Columbia, from the Judgment entered by the District Court on June 4, 1945, was duly served upon the Substituted Defendant and filed with the clerk of the Court of Appeals, by your Petitioners (R. 16).

On April 15, 1945, the Appellate Court affirmed the Judgment of the District Court, with a *per curiam* Opinion (R. 159) which was limited strictly to the subject matter of the decision of the District Court, and was strangely silent on the Affidavits in the Patent Office and the Additional Proofs in the District Court, and on the Authorities submitted to both Courts.

Jurisdictional Statement

The Jurisdiction of this Court is established by Section 240(a) of the Judicial Code as amended by the Act of February 13, 1945, now 28 U. S. Code, Sections 347(a) and 350; the pertinent provisions being as follows:

> Sec. 347(a). In any case, civil or criminal, in a circuit court of appeals, or in the United States Court of Appeals for the District of Columbia, it shall be competent for the Supreme Court of the United States, upon the petition of any party thereto, whether Government or other litigant, to require by certiorari, either before or after a judgment or decree by such lower court, that the cause be certified to the Supreme Court for determination by it with the same power and authority, and with like effect, as if the cause had been brought there by unrestricted appeal.
>
> Sec. 350. No appeal, or writ of certiorari, intended to bring any judgment or decree before the Supreme Court for review shall be allowed or entertained unless application therefor be duly made within three months after the entry of such judgment or decree, . . .

The Judgment of the Court of Appeals was entered on April 15, 1946 (R. 161), and this application for Writ of

Certiorari is duly made within three months after the entry of said Judgment.

Questions Presented

The decision of the United States Court of Appeals for the District of Columbia raises the following questions of law:

1. May a patent be refused for a sub-combination which is part of a more comprehensive combination for which a patent is granted, when the sub-combination is new and useful, and is not anticipated in structure or beneficial results by any prior patents, knowledge or use?

2. May a patent be refused upon evasive findings and conclusions which deny invention as a matter of Fact upon prior art patents, and entirely ignore some twelve separate facts, each one of which is invariably accepted as evidence of invention, and is established by undisputed proofs presented by unusually experienced and disinterested witnesses?

3. May a decision be sustained in which the court below does not comply with Rule 52 (a) of Civil Procedure, and does not "find the facts specially and state separately its conclusions of law," as required by the Rule; so as "appropriately and specifically to determine all the issues which the case presents," according to the interpretation of the Rule in *Interstate Circuit v. United States* (1938) 304 U. S. 55, 56?

4. May the presence of patentable invention be denied solely upon several prior art patents as a matter of Fact, when "no extrinsic evidence was given or needed to explain terms of art," which converts the question of invention into a matter of Law, as in *Market Street v. Rowley* (155 U. S. 621, 625)?

Reasons Relied on for the Allowance of the Writ

1. Sub-combinations are Patentable When New and Not Anticipated

The **First** reason relied on is that the refused claims are for a **new** and **useful** hollow Compression Member used as the several sections of a Radio Tower, the said hollow member also having been found meritorious commercially as a Monotube Cargo Boom (see page 12, *infra*); and the claims define **sub-combinations** which were **not anticipated** and which comprise essential subject matter of more comprehensive claims for a Radio Antenna Tower **which had been allowed as patentable** and have since been included in Patent No. 2,401,799, granted on June 11, 1946, to the Petitioners.

(a) In affirming the dismissal by the District Court, the decision of the Court of Appeals is in direct conflict with applicable decisions of this Court, in—

Railroad Company v. Du Bois (1870) 12 Wall. 47, 60, —Opinion by Mr. Justice *Strong;* as applied in

Roberts v. H. P. Nail Co. (NDO, ED-1892) 53 Fed. 916, 920 by C. J. *Taft* (before he was Chief Justice), and as recently restated in

Special Equipment v. Coe (1945) 324 U. S. 370, 376; —Opinion by Mr. Chief Justice *Stone*

(b) In the absence of any anticipation, the decision of the Court of Appeals so far departed from its own relatively recent decisions in—

Wach v. Coe (1935) 64 App. D. C. 235, 77 F. 2d. 113, 115—A. J *Robb*

Hartford Empire v. Coe (1936) 66 App. D. C. 344, 87 F. 2d. 741, 744—A. J. *Van Arsdel,* and

Kelley v. Coe (1938) 69 App. D. C. 202, 99 F. 2d. 435, 442—A. J. *Miller*

as to call for the exercise of this Court's power of supervision;

2. Evasive Findings and Conclusion

The **Second** reason relied on for the allowance of the writ, is that the findings relating to prior Patents are not factual, but are merely **speculative assumptions** which are **not supported** by the disclosure of the prior patents or by the decided cases cited in the opinion, and do not support the conclusion of both the District and the Appellate Judges, who did not **appraise** or even **mention** the **complete** and **conclusive evidence of invention** established by **Affidavits** in the Patent Office and by **testimonial** and **documentary evidence** in the District Court.

In other words the decisions of both Courts below **evade** and **ignore** the **positive proofs**, which **establish** the **presence** of **invention** and **patentability** in the pending claims, and in this respect the decision of the Court of Appeals is not supported by the very cases cited in its opinion, and has so far departed from the accepted and usual course of judicial proceedings, as recognized and applied in—

Isherwood v. Newport News (E. D. Va.—1922) 289 Fed. 282, 291—D. J. *Groner,* now Chief Justice App. D. C.

E. R. Wagner v. Porter Steel (7 CCA—1940) 116 F. 2d., 63, 67—C. J. *Sparks,* and

Goodyear v. Ray-O-Vac (1944) 321 U. S. 275, 279—Mr. Justice *Roberts*

as to call for an exercise of this Court's power of supervision.

3. No Opinion or Findings on the Ultimate Facts

The **Third** reason relied on for the allowance of the writ is that as a matter of Procedure, an Opinion or ample Findings of Fact **are required** by rule 52 of Civil Procedure, and **must be rendered** in such detail and exactness as to indicate the **subsidiary factual** basis for the ultimate con-

clusion. **Partial** Findings of Fact are **not binding** on any Court; especially when the evidentiary facts are **not** in **conflict** or in **dispute,** and when the trial **court's conclusion** rested upon **no direct testimony of a witness** as in *Mayo v. Canning Co.* (1940) 309 U. S. 310, (Page 19, *infra.*).

(a) That the **partial** Findings of Fact and Conclusions of Law and the **absence** of any Opinion by the Trial Court as affirmed by the Court of Appeals, call for an exercise of the power of supervision by this Court, is recognized in—

Aetna Life v. Kepler (8 CCA—1941) 116 F. 2d. 1, 5—C. J. *Sanborn*

Kuhn v. Princess Lida (3 CCA—1941) 119 F. 2d. 704, 705—C. J. *Jones*

Kelley v. Everglades (1943) 319 U. S. 415 *Per Curiam*

(b) That the **absence** of any Opinion or Findings in both Courts below on the **additional proofs** presented at the trial, which was an Equitable Action under Section 4915 R. S. and is a proceeding *de novo* upon the **whole merits,** requires an exercise of the power of supervision by this Court, is recognized in—

Interstate Circuit v. U. S. (1938) 304 U. S. 55, 56—*Per Curiam*

American Steel v. Coe (1939) 70 App. D. C. 138, 105 F. 2d 17, 19—A. J. *Miller*

Nichols v. Minnesota (4 CCA—1940) 109 F. 2d. 162, 163—C. J. *Parker*

(c) With the **complete record** before it containing all the documentary and testimonial evidence, none of which is disputed and there is no question as to the credibility of any witness; the Court of Appeals should have exercised its **jurisdiction,** its **power,** and its **duty,** to take the case submitted to it by the **complete record,** and was in as good condition as the Trial Court to consider and determine the undisputed Facts and **make its own conclusions of Law**

upon the Affidavits in the Patent Office and the Additional Proofs in the Trial Court; which situation requires an exercise of the power of supervision by this Court, according to—

Sun Insurance v. Be-Mac (8 CCA—1942) 132 F. 2d. 535, 536—C. J. *Woodrough*

Sbicca-Del Mac v. Milius (8 CCA—1944) 145 F. 2d. 389, 400—C. J. *Thomas*

Stubbs v. Fulton (5 CCA—1945) 146 F. 2d. 558, 560—C. J. *Lee*

4. Here the Presence of Invention is a Question of Law

The **Fourth** reason relied on for the allowance of the writ is that in the present proceeding the ordinary rule that **invention** is a **question** of **fact** does not apply, because—

(a) When the presence of invention is denied upon a showing of a number of prior patents, and "**no extrinsic evidence was given or needed to explain terms of art,**" • the presence of invention is **purely** a **question of Law**, according to the decisions of this Court in—

Mahn v. Harwood (1884) 112 U. S. 354, 358—Mr. Justice *Bradley*

•*Market Street v. Rowley* (1895) 155 U. S. 621, 625—Mr. Justice *Shiras*

United States v. Esnault-Pelterie (1938) 303 U. S. 26, 30—*Per Curiam*

(b) And when the **complete record** shows by **undisputed Facts** that the Improvement required **comprehensive calculation** and special and **extensive tests** to obtain **recognition**, and attained **unexpected results** which were **revolutionary** and **radically different from** and an **innovation** over any **prior device**, and **satisfied** an **existing need**, the Improvement being **lighter** and **stronger** and **more efficient** than the **previous Standard**, and has been so **extensively used** that it **established a new industry**; every Fact is es-

tablished which was ever thought to be necessary to show the presence of patentable **invention as a matter of Law,** according to the decisions of this Court in—

Expanded Metal v. Bradford (1909) 214 U. S. 366, 381—Mr. Justice *Day*

Diamond Rubber v. Consolidated (1911) 220 U. S. 428, 435—Mr. Justice *McKenna*

Minerals Separations v. Hyde (1916) 242 U. S. 261, 270—Mr. Justice *Clarke*

and the refusal of a patent by the Courts below, calls for an exercise of the power of supervision by this Court.

Neither the District Court nor the Court of Appeals referred in any manner to the foregoing authorities, substantially all of which were called to their attention.

In Conclusion, the **Findings** of **Fact** do not expressly indicate any **actual anticipation**; and the **decided cases** cited by the Court of Appeals **do not apply** to the present situation, because—

In *Tropic-Aire, Inc. v. Sears, Roebuck & Co.* 44 F. 2d. 580, 593, there was **extensive advertising** and the public had some **intervening rights,** which is not the situation here.

In *Ternstedt Mfg. Co. v. Motor Products Corp.* 119 F. 2d. 834, there was an **insufficient description** and **actual anticipation,** which are not present here.

In *Morrison v. Coe* 112 F. 2d. 793, there was **actual anticipation,** and a **mere transposition of parts** from the "**inside**" to the "**outside,**" which is not the situation here.

In *Textile Machine Works v. Hirsch Co.* 302 U. S. 490, 498, Mr. Chief Justice *Stone* expressly pointed out that—

> "Commercial success may be decisive **where invention is in doubt.**"

which is the situation here with respect to the DeVou patent (R. 153), which is believed to be the best reference

relied upon below for rejecting the claims and refusing a patent.

WHEREFORE, your petitioners respectfully pray that a Writ of Certiorari issue out of and under the seal of this Court, directed to the United States Court of Appeals for the District of Columbia, commanding said court to certify and send to this Court on a day designated, a full and complete transcript of the Record and Exhibits and of all the proceedings had in said Court of Appeals in this case, to the end that this case may be reviewed and determined by this Court as to the questions presented hereby; that the judgment of said Court of Appeals be reversed; and that petitioners be granted such other and further relief as may be deemed proper.

Respectfully submitted,

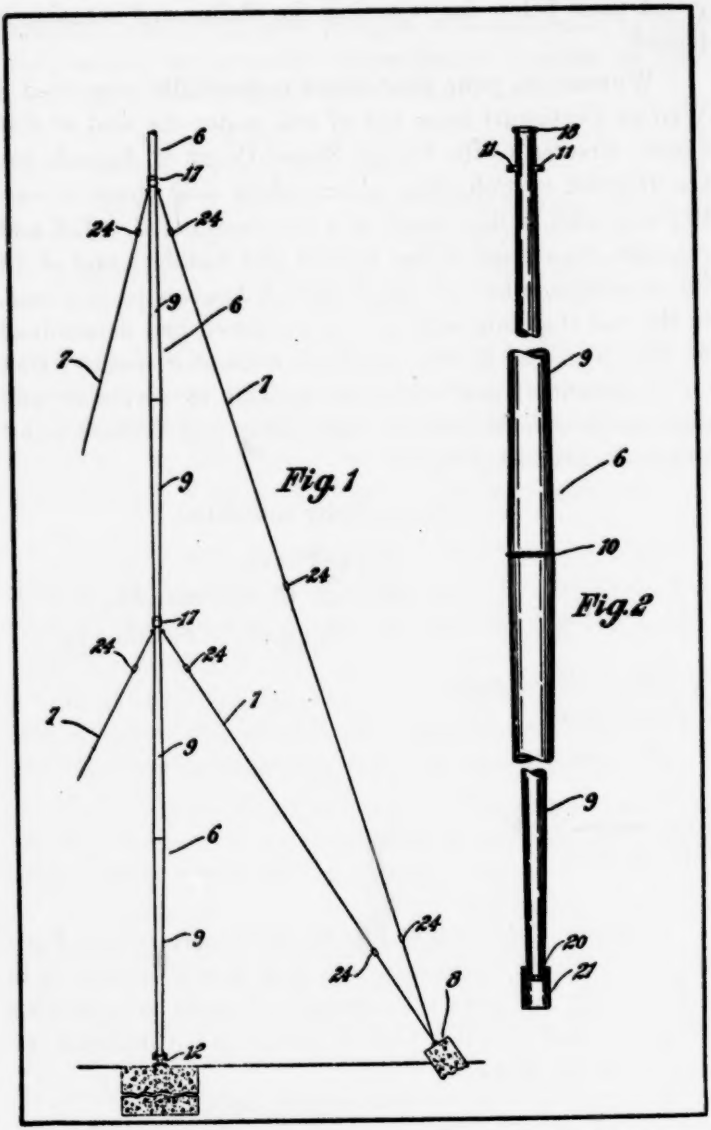
HARRY FREASE,
EDWARD R. WALTON, JR.,
Counsel for Petitioners.

EVERETT R. HAMILTON,
JOSEPH FREASE,
Of Counsel.

Washington, D. C.
July 12, 1946.

I HEREBY CERTIFY that I have read the foregoing Petition for Writ of Certiorari, and that in my opinion it is well founded and presents adequate grounds for granting the prayer, and I further CERTIFY that it is not intended for the purpose of delay.

HARRY FREASE,
Of Counsel.



Application Drawing (R. 110)—Fig. 1. Radio Tower
Fig. 2. Compression Member Section—Cargo Boom

In the Supreme Court of the United States

OCTOBER TERM, 1945.

No. .....

THE UNION METAL MANUFACTURING COMPANY,
and
EDMUND W. RIEMENSCHNEIDER, and
MABEL ST. ELMO RASTETTER,
Executrix of HARRY O. RASTETTER, Deceased,
Petitioners,

vs.

CASPER W. OOMS,
as Commissioner of Patents,
Respondent.

BRIEF IN SUPPORT OF PETITION FOR WRIT OF CERTIORARI

Opinions of the Courts Below

The District Court did not deliver or render any Opinion, but its Findings of Fact, its Conclusions of Law, and its Judgment appear in the Record filed herewith (R. 13, 15, 16).

The *Per Curiam* Opinion of the United States Court of Appeals for the District of Columbia is reported in 154 F. 2d. 857 and in 69 USPQ 153, and appears in the Record filed herewith (R. 159). Its Judgment is in page 161 of the Record.

Jurisdiction

The jurisdiction of this Court is invoked under the provisions of the Section 240 (a) of the Judicial Code as amended in 28 U. S. Code, Sections 347 (a) and 350, which are quoted in the Petition at page 4, *supra.*

Statement of the Case

The matters material to the consideration of the questions presented, are briefly

1. The **refusal** of new and useful sub-combination claims which are not anticipated (R. 55), **after allowing** more comprehensive claims (R. 52) **which have been patented.**

2. The admissions of the Examiner that some of his reasons for rejecting the pending claims were **"mere speculations"** (R. 96), and that the affidavit shows "that the **double tapered** boom is **more efficient** than the **straight type** boom" (R. 127); and the admissions of the Board that **"there may be some doubt concerning"** the principal reference (R. 153), and that the affidavit **"shows commercial success** of the applicants' device" (R. 154).

3. The Judgment of the District Court dismissing the Complaint under Section 4915 R. S., in the face of the foregoing admissions, **solely** upon Findings and Conclusions limited to prior patents **that do not anticipate**; without any reference to the **undisputed evidence** of **invention** presented to the Court, as epitomized at page 21, *infra.*

4. The judgment of the Court of Appeals affirming said dismissal, upon the same **fallacious Findings** and upon the same **evasion** of the **evidence of invention** and the **controlling authorities** which were **ignored** by the District Court (R. 159, 161).

Specification of Errors

The United States Court of Appeals for the District of Columbia erred:

1. In refusing a patent for a sub-combination which is part of a more comprehensive patentable combination, when the structure of the sub-combination is **new** and **useful** and is **not anticipated** by any one or all of prior patents relied

upon, and when the **beneficial results** flowing from the sub-combination are **not obtained** by the prior patents.

2. In refusing a patent upon **speculative assumptions** not supported by any prior patents or by the decided cases relied upon, and which **do not appraise** or **apply** the substantial **evidence** of **invention** submitted in the Patent Office, or the very **complete, comprehensive** and **conclusive additional testimonial** and documentary **evidence of invention presented in the Trial Court.**

3. In refusing a patent **without rendering any opinion, findings** or **conclusions** on the undisputed **evidence** of **invention,** submitted to the Patent Office and to the Trial Court, as required by Rule 52 (a) of Civil Procedure.

4. In refusing a patent on **fallacious** findings of **fact** when the complete record shows by undisputed facts that the improvement defined by the pending claims **involves invention** as a matter of **law.**

ARGUMENT

The Facts set forth in the Petition will not be repeated. Pertinent paragraphs from the Authorities will be quoted and amplified, as may be desirable.

1. Sub-Combinations are Patentable When New and Useful and Not Anticipated

(a) This Court has invariably held that sub-combinations which are **new** and **useful** are patentable under Article I, Section 8 of the Constitution and Section 4886 R. S.; 35 U. S. C. 31. Thus—

In *Railroad Company v. DuBois* (1870) 12 Wall. 47, at page 60 it was said by Mr. Justice *Strong* that—

> "Undoubtedly a patentee may claim and obtain a patent for an **entire combination,** or process, and also for such **parts** of the **combination** or process as are **new** and **useful,** or he may claim and obtain a patent for **both.**"

In *Roberts v. H. P. Nail Co.* (N. D. O., E. D. 1892) 53 Fed. 916, beginning at page 920, it was said by Circuit Judge (later Mr. Chief Justice) *Taft* that—

> "In a combination patent it is permissible for the patentee, after claiming his **whole machine**, to claim also the combination of **fewer parts** than the whole, provided the **combination** of the parts is **new** . . .
>
> "That patentees may properly protect what is **really new** in the combination, they must therefore be given the opportunity to select out a **part or parts** which are **new**, less than the whole working machine, and by their claims warn the public against the use of them in any other combination to accomplish the same general result as that for which they were used by the patentee in his complete machine."

In *Special Equipment Co. v. Coe* (1945) 324 U. S. 370, beginning at page 376 it was said by Mr. Chief Justice *Stone* that—

> "A patent on the combination embodied in the complete machine, without the allowance of the **subcombination** claims, would not, as the court below thought, prevent the free use of the subcombination . . ."
>
> "Hence denial of a patent on the subcombination would deprive the inventor of the benefit of the exclusive right to use the **subcombination** in the ways specified by the patent laws. It would also leave the public free to use, and thus to appropriate a **part**, however important, of the inventor's complete machine, even though patented.
>
> "If, as we must assume, petitioner has two inventions, both of which are useful and one of which includes the other in its entirety, it is evident that the value of the former would be **greatly impaired** if the **subcombination** invention could be freely used by others. . . .
>
> "**The statutes permit**, and it is the settled practice of the Patent Office, **many times sustained by this Court**, to allow, claims to a combination and **also its subcombinations**."

The present situation comes squarely under the rule of the foregoing decisions. Claims covering the **complete combination** of a radio tower having a plurality of the compression member sections were allowed in the Parent Application, and have since been patented. Pending Claims 1 and 2, covering the **subcombination** of one of said compression members in the Divisional Application, have been refused allowance by the Patent Office and by the District Courts, and constitute the subject matter of this Petition.

The principle of the foregoing decisions is reflected in the text of Section 4915 R. S., now in Section 63, Title 35, of the United States Code, the pertinent portions of which are as follows:

> **Sec. 63. Bill in Equity to obtain a patent.**
>
> Whenever a patent on application is refused by the Board of Appeals, . . . the applicant . . . may have remedy by bill in equity, . . .; and the Court having cognizance thereof, . . . may adjudge that such applicant is entitled, according to law, to receive a patent for his invention, as specified in his claim or **for any part thereof**, as the facts in the case appear.

(b) The sub-combinations were **not anticipated** by the prior patents relied upon, according to the rule of decision—

In *Wach v. Coe* (1935) 64 App. D. C. 235, 77 F. 2d., 113, at page 115 Associate Justice *Robb* quoted from *Lucke v. Coe,* 63 App. D. C. 61, 69 F. 2d., 379, 383, and applied the same, as follows—

> " 'All the patents relied upon by the Patent Office as anticipating Lucke's device were before these engineers, yet, highly skilled in the art as they were, **they were unable to do what Lucke has done**; . . .
>
> " 'It is comparatively easy, now that the Lucke device is in evidence, to take **this and that** from the references and achieve a **nunc pro tunc solution** of the problems confronting Lucke when he made his invention.' . . .

"Where, as here, the new device is also useful and marks a distinct and novel advance in the art, **it should receive patent protection.**

"**For almost 25 years,** as we have seen, patents have been granted in this art on devices that proved to be practically worthless, and yet appellant has been refused a patent on his successful device because the Patent Office has found that, by **taking this and that** from the **unsuccessful patents,** the result achieved by appellant could have been accomplished."

In *Hartford-Empire Co. v. Coe* (1936) 66 App. D. C., 344, 87 F. 2d 741, at page 744 it was said by Associate Justice *Van Orsdel* that—

"We have had occasion in many instances to **condemn the hindsight nunc pro tunc** method employed to justify the refusal of valuable inventions in which the patentees are entitled to the protection afforded by the Constitution and the laws."

In *Kelley v. Coe* (1938) 69 App. D. C. 202, 99 F. 2d., 435, at page 442 it was said by Associate Justice *Miller* that—

"The Commissioner's argument in the present case comes down to the same result. He contends that anyone skilled in the art could have taken **this** and **that** from the various patents and, **putting them together,** could have devised the Kelley method.

"But the fact remains that, in the face of a **crying need** for a new process or method in the industry, not one of the best engineers in the world, with their attention especially directed to the subject for approximately thirty years, **was able to see** what Kelley saw, or to **produce** the **result** which he produced.

"The evidence in support of appellants' application established beyond doubt their right to the issuance of a patent."

The Primary Examiner did not deny any of the Facts set forth in the Applicants' Affidavit, but accepted them as true by saying in his Statement that—

> "This affidavit shows that applicants sold a **large number** of **double tapered** booms due to the U. S. and British ship program, and that the **double tapered** boom is **more efficient** than a **straight** type boom shown in Exhibit B, attached to the affidavit." (R. 127)

And the Board of Appeals likewise admitted that "**there may be some doubt concerning De Vou,**" the best reference relied upon (R. 153), and that—

> "The affidavit referred to by the examiner shows **commercial success** of the **applicants' device** but he is not satisfied that the success is due to the inventive or unobvious nature of the construction." (R. 154)

Presumably, if the additional proofs subsequently presented in the District Court had been before the Examiner, he would have been satisfied.

The Examiner sought to avoid the effect of the Facts in the Affidavit by **purely speculative inferences, suppositions, assumptions and arguments** having no foundation whatever in the record, and none of them affecting in any manner the force of the foregoing decisions.

In a similar situation it was well said by Mr. Chief Justice *Marshall* in *Fletcher v. Peck* (1810) 6 Cranch 87, 147, that—

> "It is our **duty** to decide on the **rights**, but not on the **speculations** of parties."

If there were any facts set forth in the Examiner's Statement, they were not sufficient to support the **ultimate conclusion of no invention,** for the reasons set forth—

In *Mayo v. Canning Co.* (1940) 309 U. S. 310, wherein at page 316 it was said by Mr. Justice *Roberts* that—

> "**Statements of fact** are mingled with **arguments** and **inferences** for which we find **no sufficient basis** either in the **affidavits** or the **oral testimony.**"

2. Evasive Findings and Conclusions

The Court of Appeals followed the District Court in avoiding any reference to the **complete** and **conclusive evidence** of **invention** in the Trial Court by the following **highly skilled** and **disinterested** witnesses.

John Fleming, an experienced shipbuilder from the Royal Dock Yards at Portsmouth, England, and in the Bethlehem Shipbuilding Corporation in this Country, and now a Naval Architect with Gibbs & Cox, Inc., of New York City; who was familiar with **the swage pipe type** of metal boom for **something like 28 years in shipbuilding**; and testified that the Monotube boom was "Quite **revolutionary and radically different from those we had used in the past.**" (R. 26)

E. W. Sundstrom, Director of Maritime Commission depots, Captain in the United States Naval Reserve, previously assigned to the British Admiralty, and a Master of Merchant ships from 1917 to 1941; who testified that "**Approximately 75 per cent of all ships built**" by the Maritime Commission since 1942 have been equipped with the Union Metal Cargo Booms. (R. 30)

H. A. Alvig, a graduate Naval architect from Norway, engaged in designing and building ships and in charge of rigging and cargo handling for the Maritime Commission for some six years, and since 1921 engaged in shipbuilding involving the design of cargo booms; who testified that "**this concern had developed a new boom**" that was "**more efficient**" **than the standard swage pipe boom, "which I had seen to fail in tests on shipboard.**" (R. 32, 33)

Francis G. Ebel, a Naval Architect of Washington, D. C., engaged for seven years with the United States Maritime Commission and since 1940 investigating the design of booms **because of failures** in the **standard swaged type booms**; who testified that "**in the year 1940, we had had some failures of booms of that swaged type** and we were

making investigation of the design of booms," and that **"This tapered type boom was an innovation."** (R. 37, 38)

Walter B. Vick, a graduate of Ohio State University in civil structural engineering, engaged for some twelve years as an engineer for the Appellant in charge of Sales of its Monotube poles and of its Cargo Booms since 1940; who testified that **"It was a revolutionary design to them,"** that is, to the members of the Maritime Commission. (R. 35)

The testimony of these witnesses established the following Facts—

(a) The **Improvement** defined by the pending claims required **comprehensive calculations,** and a

(b) **Recognition** of its **beneficial results** required **special** and **extensive tests,**

(c) Which disclosed **unexpected results,**

(d) That were **revolutionary** in **character,**

(e) Were **radically different** and

(f) Were an **innovation over any prior devices**

(g) And satisfied an **existing need;** and that

(h) The **Improvement** is **lighter** and **stronger,** and

(i) Is **more efficient** than the **previous Standard Pipe Boom**

(j) And has been so **extensively used** that

(k) It has **established** a **new industry,** and

(l) **Has** largely **replaced** all **earlier devices.**

These Facts bring the status of the pending claims directly under the rule of decision in somewhat similar situations,—

In *Isherwood v. Newport News* (E. D. Va.—1922) 289 Fed. 282, at pages 291 and 292 it was said by District Judge (now Chief Justice) *Groner* that—

"The advantage of the system is the saving of metal in the **construction** of the ship without impairing the strength of the stiffness of the vessel." (p. 291)

"Up to the present time more than 1400 ships, representing approximately 12,000,000 tons deadweight carrying capacity, have been constructed on this system, and, in a recent decision construing the Isherwood English patent, the High Court of Justice, Chancery Division, in an opinion, which was submitted to me in the argument, says:

"The 'Isherwood invention, like so many other great discoveries, is, when understood, of **extreme simplicity**—the step between failure and attainment a short one—the **result** of **attainment** almost **epoch-making.** It is a remarkable example of **'the little more'** and **'the little less,'** and, as might be expected, it has as forerunners many an untried or unsuccessful effort in the same field of invention superficially similar to itself, and presenting perhaps after its publication the **appearance** even of **anticipation.**' " (P. 292)

In *E. R. Wagner v. Porter Steel* (7 C. C. A.—1940) 116 F. 2d. 63, at page 67 it was said by Circuit Judge *Sparks* that—

"Conceding for the purpose of the argument, that the elements are all old and that each element used produces no new result, yet we are convinced that a **beneficial result** has been produced in a **more efficient, economical** and **facile** manner, and we feel constrained to hold the claims **valid.**"

In *Goodyear v. Ray-O-Vac Co.* (1944) 321 U. S. 275, at page 279 it was said by Mr. Justice *Roberts* that—

"**Viewed after the event,** the means Anthony adopted seem simple and such as should have been obvious to those who worked in the field, **but this is not enough to negative invention.**

"During a period of **half a century,** in which the use of flashlight batteries increased enormously, and the manufacturers of flashlight cells were conscious of the defects in them, **no one devised a method of curing such defects.**

"Once the method was discovered it commended itself to the public as evidenced by **marked commercial success.**

"These factors were entitled to weight in determining whether the improvement **amounted to invention** and should, in a close case, **tip the scales in favor of patentability.**"

3. No Opinion or Findings on the Ultimate Facts

Rule 52 of Civil Procedure requires findings in such **detail** and **exactness** as the nature of the case permits, of **subsidiary facts** on which the **ultimate** conclusion can be rationally predicted.

(a) **Partial** Findings of Fact are not sufficient in the present proceeding, under the rule of decision in the following cases—

In *Aetna Life v. Kepler* (8 C. C. A.—1941) 116 F. 2d., 1, at page 5 it was said by Circuit Judge *Sanborn* that—

"This Court . . . is no longer merely a court of error which considers **only** questions of **law.** It now acts as a court of review in all non-jury cases in accordance with the practice which formerly prevailed in equity appeals.

"The findings of fact of the court below to the extent that they are unsupported by **substantial evidence,** or are clearly against the **weight** of the **evidence,** or were induced by an **erroneous view** of the **law,** are **not binding** upon this Court."

In *Kuhn v. Princess Lida* (3 C. C. A.—1941) 119 F. 2d, 704 at page 706, it was said by Circuit Judge *Jones* that—

"Where the evidentiary facts are not in **conflict** or **dispute,** the conclusions to be drawn therefrom are **for** the **appellate court** upon **review** of the trial court's action . . .

"An incorrect conclusion by a trial court qualifies as a **'clearly erroneous'** finding, for the correction whereof on appeals Rule 52 (a) **specifically provides.**

"In the instant case, the trial court's **conclusion** . . . rested upon **no direct testimony of witnesses.**"

In *Kelley v. Everglades* (1943) 319 U. S. 415, beginning at page 420 it was said *Per Curiam* that—

> "There must be findings, in such **detail** and **exactness** as the nature of the case permits, of **subsidiary facts** on which the **ultimate conclusion** . . . can rationally be predicated.
>
> "The findings in the present case fall short of that requirement. **Appropriate facts** which might have been considered . . . are nowhere referred to in the opinion or findings below . . ."

The conclusion of the District Court was **not binding** on the Court of Appeals because the findings below **were not concurred in by two courts**; the Patent Office Examiner and the Board of Appeals being **merely administrative agencies**, and a Court is **"not bound by the decision of the Commissioner."** See *Mahn v. Harwood*, 112 U. S. 354, *infra*, Page 26.

(b) An action under Section 4915 R. S. is a proceeding *de novo* upon the **whole record** and requires special and formal findings on **all the issues** under the rule of decision—

In *Interstate Circuit v. United States* (1938) 304 U. S. 55 at page 56 it was said *Per Curiam* that—

> "The District Court did not comply with this rule [70½ now 52]. The Court made no formal findings. **The court did not find the facts specially and state separately its conclusions of law as the rule required."**
>
> . . .
>
> "**The opinion of the court was not a substitute for the required findings.** A discussion of portions of the evidence and the court's reasoning in its opinion do not constitute the **special** and **formal findings** by which it is the **duty** of the court appropriately and specifically to determine **all the issues** which the case presents."

In *American Steel & Wire v. Coe* (1939) 70 App. D. C. 138, 105 F. 2d. 17, at page 19 it was said by Associate Justice *Miller* that

"The proceeding under Section 4915 R. S., 35 U. S. C. A. § 63, is a proceeding **de novo in equity**, and, while the inquiry therein must be confined to the invention claimed in the Patent Office, nevertheless, 'It is not a technical appeal from the Patent Office, like that authorized in § 4911 [35 U. S. C. A. § 59a], confined to the case as made in the record of that office, but is **prepared** and **heard** upon **all competent evidence** adduced and **upon the whole merits.**' "

In *Nichols v. Minnesota Mining* (4 C.C.A.—1940) 109 F. 2d 162, at pages 163 and 166 it was said by Circuit Judge *Parker* that—

"The Patent Office record was before the judge below and was considered by him in connection with **further testimony of Swenson, additional expert testimony** and **evidence** of **experiments** conducted under the court's direction. He properly . . . found that the **additional evidence** brought out the issues **much more clearly** than had theretofore been done, and held that in the light thereof Swenson was clearly shown to have priority. (p. 163)

"The evidence offered in the court below . . . consisted of expert testimony and experiments designed to **strengthen** the **contentions** already fully made and supported by testimony **before** the Patent Office.

"A suit under R. S. § 4915 is not in the nature of an appeal but of a **trial de novo**; and the court has all the customary power of an **equity court** to hear the evidence fully and **make its own findings.**" (P. 166)

(c) With the **Complete Record** before it, the power of supervision of the Appellate Courts has been exercised in sundry circuits, **without remanding** the case for further proceedings below—

In *Sun Insurance v. Be-Mac* (8 C.C.A. 1942) 132 F. 2d 535, at page 536 it was said by Circuit Judge *Woodrough* that—

"There was no conflict in evidence and the appeal **imposes** on **this court** the **duty** of ruling upon the **questions** of **law** presented."

In *Sbicca-Del Mac v. Milius Shoe* (8 CCA—1944) 145 F. 2d 389, at page 400 it was said by Circuit Judge *Thomas* that—

> "The trial court made no findings of fact nor conclusions of law, . . . upon the defenses of **ouster** and **waiver.**
>
> "Since the facts relied upon to **support** these two **defenses** are **in the record** and **undisputed** we **shall not remand** the case for this reason alone but will in the **exercise** of our **jurisdiction** under such circumstances **consider** and **determine them.**"

In *Stubbs v. Fulton* (5 C.C.A. 1945) 146 F. 2d., 558, at page 560, it was said by Circuit Judge *Lee* that—

> "Few, if any, of the primary facts are in dispute. The dispute has to do with the **inferences** or **conclusions** drawn from the facts.[1]
>
> "[1] Where the facts are not in dispute, inferences and conclusions drawn by the trial court are not binding on the appellate court, which remains free to draw inferences and **conclusions** which in its opinion the findings **reasonably** induce."

No argument is needed to show the particular pertinence of the foregoing authorities.

4. Here the Presence of Invention is a Question of Law.

In the present proceeding the ordinary rule that invention is a question of **fact** does not apply, because—

(a) The presence of invention is **purely** a **question** of law when "**no extrinsic evidence was given or needed to explain the art,**" according to the decisions of this Court—

In *Mahn v. Harwood* (1884) 112 U. S. 354, at page 358 it was said by Mr. Justice *Bradley* that—

> "In cases of patents for inventions, a valid defence not given by the statute often arises where the question is, whether the thing patented amounts to a patentable invention. This being a **question of law,** the

courts are **not bound** by the decision of the **commissioner,** although he must necessarily pass upon it."

In *Market Street v. Rowley* (1895) 155 U. S. 621 at page 625 it was said by Mr. Justice *Shiras* that—

> "**No extrinsic evidence was given or needed** to explain terms of art, or to apply the descriptions to the subject-matter, so that the court was **able,** from **mere comparison,** to say what was the **invention** described in each, and to affirm from such **mere** comparison whether the inventions were or were not the same.
>
> "The question was, then one of **pure construction** and **not of evidence,** and consequently was **matter of law** for the court, without any **auxiliary fact** to be passed upon by the jury."

In *United States v. Esnault-Pelterie* (1938) 303 U. S. 26, at page 30 the foregoing Rule of Decision which is particularly pertinent here, was repeated *Per Curiam* as follows:

> "Where, with **all the evidence** before the court, it appears that no **substantial dispute of fact** is presented, and that the case may be determined by a mere comparison of structures and **extrinsic evidence is not needed** for purposes of explanation, or evaluation or prior art, or to resolve questions of the application of descriptions to subject-matter, the questions of **invention** and infringement **may be determined as questions of law."**

(b) **The complete record,** shows, as pointed out in page 9, *supra,* that every Fact has been presented which has ever been deemed necessary to show the **existence** of **patentable invention** as a matter of **Law,** in accordance with the decisions of this Court—

In *Expanded Metal v. Bradford* (1909) 214 U. S. 366, at page 381, wherein it was said by Mr. Justice *Day* that—

> "It may be safely said that if those skilled in the mechanical arts are working in a given field and **have failed after repeated efforts to discover a certain new**

and useful improvement, that he who first makes the discovery has done more than make the **obvious improvement** which would suggest itself to a mechanic skilled in the art, **and is entitled to protection as an inventor."**

In *Diamond Rubber v. Consolidated Tire* (1911) 220 U. S. 428, at page 435 it was said by Mr. Justice *McKenna* that—

> **"If he has added a new and valuable article to the world's utilities he is entitled to the rank and protection of an inventor."**

In *Minerals Separation v. Hyde* (1916) 242 U. S. 261, at page 270 it was said by Mr. Justice *Clarke* that—

> "Because of its **economy** and **simplicity,** it has largely replaced all earlier processes.
>
> "This, of itself, is persuasive **evidence** of that **invention** which it is the purpose of the patent laws to **reward** and **protect.**"

In Conclusion

As pointed out in the Petition, the United States Court of Appeals for the District of Columbia has completely ignored the provisions of the Constitution and the Statutes, and the foregoing decided cases relied upon by your Petitioners.

In so doing, the Court of Appeals has **decided a federal question** in **actual conflict** with some fourteen **applicable decisions** of this Court, with some four well considered earlier decisions in its own Court, and with some nine typical decisions in several Circuit Courts of Appeal.

More specifically, it has not given any effect whatever to the relatively recent decisions of this Court in *Special Equipment v. Coe* on the **First** question, in *Goodyear v. Ray-O-Vac* on the **Second** question, in *Interstate Circuit v. United States* on the **Third** question, and in *United States v. Esnault-Pelterie* on the **Fourth** question presented by your Petitioners.

This situation is believed to call for an exercise of this Court's power of supervision, to the end that the four questions of patent law here involved may be finally determined by this Court upon a full consideration of the complete record, which is believed will result in a reversal of the judgment of the Court below.

Respectfully submitted,

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Washington, D. C.
July 12, 1946.

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CHARLES ELMORE CRO

In the Supreme Court of the United States

OCTOBER TERM, 1945.

No. 292

THE UNION METAL MANUFACTURING COMPANY,
and
EDMUND W. RIEMENSCHNEIDER, and
MABEL ST. ELMO RASTETTER,
Executrix of HARRY O. RASTETTER, Deceased,
Petitioners,

vs.

CASPER W. OOMS,
as Commissioner of Patents,
Respondent.

ON PETITION FOR WRIT OF CERTIORARI TO
THE UNITED STATES COURT OF APPEALS
FOR THE DISTRICT OF COLUMBIA.

REPLY BRIEF IN SUPPORT OF PETITION

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REPLY BRIEF IN SUPPORT OF PETITION

The Brief for the Respondent in Opposition naively devotes substantially all of the Statement and Argument to a discussion of the well known rule, that commercial success is not conclusive evidence of invention; with the obvious purpose of making it appear that the Petitioners rely **entirely** and **solely** on "**commercial success**" evidence to establish the presence of invention in their improvement.

That discussion is very misleading and Respondent's Brief is silent on the Reasons Relied On in the Petition for the Allowance of the Writ, which include reference to **positive** and **undisputed evidence** of many **additional facts** showing the presence of invention, which proofs were presented to the trial court by numerous **highly skilled** and absolutely **disinterested witnesses.**

ADDITIONAL EVIDENCE OF INVENTION

The additional evidence of invention establishes numerous facts which frequently have been held sufficient to show invention; and the combination of all of the facts taken together conclusively establishes the presence of invention in Petitioner's improvement.

The **established facts** show—

1. That a **recognition** of the **beneficial results** of the improvement required **comprehensive calculation** and **special** and **extensive tests**, and did **not** result from **sales energy***;

2. That the **tests** disclosed **unexpected results** which were **revolutionary** in **character** and were **radically different** from and were an **innovation over** any **prior device**†;

3. That the **improvement satisfied** an **existing need**; because it was **lighter** and **stronger** and was **more efficient** than the previous **Standard swaged pipe boom**‡;

and

4. That the **improvement** has been so **extensively used** that it has **established** a **new industry**, and has **largely replaced** all **earlier devices**§.

Respondent's Brief beclouds the issue in stating that these proofs **only show commercial success.** The proofs were not presented for this purpose at all, but to establish Riemenschneider and Rastetter's contribution to the art in **solving a problem**, and **satisfying** a **need** by a **new structure**

---

* **Fleming**, R. 26, 27; **Sundstrom**, R. 30; **Alvig**, R. 32, 33; **Vick**, 34, 35, 36; **Ebel**, R. 38, 39.

† **Fleming**, R. 26; **Vick**, R. 35; **Ebel**, R. 38.

‡ **Fleming**, R. 25, 26, 27; **Sundstrom**, R. 29, 30; **Alvig**, R. 33; **Vick**, R. 35, **Ebel**, 38, 39.

§ **Fleming**, R. 26, 27; **Sundstrom**, R. 29, 30; **Alvig**, R. 33; **Vick**, R. 35, 36; (See also R. 117, 118).

obtaining **new results, operations, functions** and **purposes, never before known or existing.**

RIEMENSCHNEIDER AND RASTETTER'S ACHIEVEMENT INVOLVES INVENTION

The **undisputed facts** of record show that **when** the **problem** was **submitted** to Riemenschneider and Rastetter they **suddenly perceived** the availability of existing elements and then conceived the idea of combining them in a **new** and **useful structure** having the **necessary functions** to **solve** the **problem** in a manner which had **never been anticipated**; all of which resulted from their **infinite capacity** for **taking pains** which was utilized in their development, so as to **qualify** them as **inventors** under the **most severe conditions** which have **ever been required** by this or any other Court.

During the recent World War II there were many **crying needs** which had to be satisfied if the prosecution of the war was to be successful. The genius of Americans and American Industry satisfied those needs and solved the problems existing. The steps taken by Riemenschneider and Rastetter in solving the problem of handling cargo by ship booms, created by the need of transporting **locomotives, tractors** and **tanks, aeroplanes** and **jeeps**, and heavy war material of every description, across the seven seas to the four corners of the earth, is but one example of the exercise of such genius.

The additional proofs presented to the trial court, which were ignored by that court in its Findings and Conclusions, establish that Riemenschneider and Rastetter **solved** a tremendously important and **unsolved problem** and **satisfied** a **crying need.**

These proofs further established their Ship Boom as an entirely **different Structure**, which obtained new and **unexpected Results** and **Functions** and operated in a **different manner** for an entirely **different purpose** than the struc-

tures, results, operations, functions and purposes of the devices disclosed in the patents which the courts below erroneously found to be anticipating.

Not one of these prior devices **solved** the **problem** or **satisfied** the **crying need.** Not one of these prior devices **suggested** a **solution** of the **problem** nor **suggested** Riemenschneider and Rastetter's **structure, results, operations, functions** and **purposes.**

SILENCE OF THE RESPONDENT

For some unaccountable reason, the Brief for the Respondent, like the decisions of the District Court and the Court of Appeals, has seen fit to ignore the foregoing facts. This silence is believed to justify a Writ of Certiorari upon **each one** of the **Questions** Presented and the Reasons Relied On, (A) because those **facts conclusively** establish—

1. The **presence** of **invention** in the sub-combination claims which have been refused;

2. The **absence** of **anticipation** in any one or all of the prior art patents;

3. The **absence** of any **findings** of **fact** and **conclusions** of **law** on **all** the **evidence adduced,** as required by Rule 52(a) of Civil Procedure;

4. The **presence** of **invention** in your Petitioners' improvement, as a **matter** of **law.**

and (B) because the Court of Appeals below—

1. Has rendered a decision in **conflict** with **other** Circuit Courts of Appeals, on the same matter;

2. Has decided **each one** of the Federal Questions Presented in a way **actually** in **conflict** with **applicable decisions** of this Honorable Court; and

3. Has so far **departed** from the **accepted** and **usual course** of **judicial proceedings** on questions of **general importance;** as to call for an exercise of this Court's power of supervision under Rule 38-5-(b), (c).

RESPONDENT'S AUTHORITIES

The Brief for the Respondent cites some twenty-one decisions of this Court and four decisions of the Courts of Appeals, presumably in support of the positions taken in the Brief. It is significant, however, that the Brief has not followed the old saying that—*"If it is worthwhile to cite a case, it is worthwhile to quote from it"*—so as to enlighten the reader of any pertinence the cases may have on the Questions Presented.

Under the circumstances, all of the cited cases have been carefully reviewed, and a digest of them has been included in an Appendix to this Brief, in an effort to save the members of this Court some of the labor of considering them.

This digest shows that many of the cases cited by the Respondent are **not pertinent** at all to the Questions Presented, and that most if not all of the remaining cases are **favorable thereto** in one or more respects.

CONCLUSION

When the ignored additional evidence and all of the facts are fully and properly evaluated, it is manifest that Petitioners are entitled to the patent which they seek; and that the Petition for a Writ of Certiorari should be granted.

Respectfully Submitted,

HARRY FREASE,
EDWARD R. WALTON, JR.,
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EVERETT R. HAMILTON,
JOSEPH FREASE,
Of Counsel.

Washington, D. C.
September 5th, 1946.

APPENDIX

The cases cited by the Respondent are either **not pertinent here** or clearly **justify a Writ of Certiorari.**

CASES NOT PERTINENT

Warren v. Keep (1894) 155 U. S. 265, is not pertinent nent because there was no question of **invention** involved, but only of **priority** and **infringement,** which were there decided on **conflicting** testimony of witnesses before the trial Court. That is not the situation here, where the trial Court **ignored** the **undisputed** testimony of witnesses who **established** the **presence** of **invention,** and there was **no conflicting testimony** in the present case.

Adamson v. Gilliland (1917) 242 U. S. 350, is not pertibecause there was no question of **invention** involved, but only of the **extent** of an **infringement** shown by **undisputed** testimony before the trial Court; and **"no obvious error"** or **"mistake"** was pointed out to the appellate Court. That is not the situation here, in which there was **no testimony** before the trial Court on this subject to sustain its findings and conclusions; and **that fact was pointed out to the appellate Court.**

Hydraulic Press v. Coe (1943) 134 F. 2d 49, is not pertinent because a patent was **very properly** refused under Section 4915 R. S. for **method** claims which **did not define** applicant **improvement** which **may have involved invention.**

Page v. Arkansas Gas Corp. (1932) 286 U. S. 269, 271, is not pertinent because the only issue decided was the question of **jurisdiction.**

United States v. Commercial Credit Co. (1932) 286 U. S. 63, 67, is not pertinent because it relates solely to **"unlawful transportation of intoxicating liquors"**; and the **evidence justified** the findings, which is not the situation here.

Texas & N. O. R. Co. v. Brotherhood of Railway Clerks (1930) 281 U. S. 548, 558, is not pertinent because the only issue decided was the question of **intimidation** and **coercion.**

I. T. S. Co. v. Essex Co. (1926) 272 U. S. 429, 433, is not pertinent because there was no question of **invention** and the **concurrent findings** related to a **decree pro confesso** and the **absence** of an **estoppel,** both of which were clearly established.

Abbott v. Coe (1940) 109 F. 2d 449, 451-452 is not pertinent because there were no **additional proofs** by **distinguished** and **disinterested** witnesses such as **Fleming, Sundstrom, Alvig** and **Ebel,** who testified before the trial Court; to **overcome** the **showing** in the **Patent Office record.**

Keller v. Adams-Campbell Co. (1924) 264 U. S. 314, 319, is not pertinent because a Writ of Certiorari was dismissed when there was no question of **invention,** but only the **scope** of the invention covered by the claims, and there was no **diversity** of **decision** in different Circuit Courts of Appeals.

Layne & Bowler Corp. v. Western Well Works, Inc., (1923) 261 U. S. 387, is not pertinent because a Writ of Certiorari was dismissed under circumstances similar to those in the *Keller* case.

General Talking Pictures Corp. v. Western Electric Co. (1938) 304 U. S. 175, is not pertinent because the "Questions Presented" related only to **sales restrictions** and **delayed claims** without any question of **invention.**

Keyes v. Grant (1886) 118 U. S. 25, is not pertinent because there was **conflicting evidence** in an **action** at **law** which **required** a **verdict** from the jury; and the cause was **very properly remanded** for a new trial.

McClain v. Ortmayer (1891) 141 U. S. 419, is not pertinent because one of the reasons why large sales are not always conclusive evidence, was said to be that—

> "It is impossible from this testimony to say how far the large sales of these pads is due **to their superiority to others**, or to the **energy** with which they were **forced** upon the **market.**" (Page 428.)

which reason does not apply to the present case, because here the "**superiority**" of the structure, and not any sales "**energy**", caused the extensive use of the product.

Dow Co. v. Halliburton Co. (1945) 324 U. S. 320, 330, is not pertinent because **invention** was properly denied for "3. The application of an old process to a new and analogous use"; which is not the situation here.

DECISIONS JUSTIFYING A WRIT

In *Magnaflux Corp. v. Coe* (1943) 139 F. 2d 531, the absence of invention was resolved merely upon the "**subjective opinion**" of the trial Court, was **contrary** to **undisputed** evidence, and was **improperly affirmed** by the Court of Appeals upon the **untenable theory** that—

> "**This court's function is not to register its opinion**",

as erroneously expressed in *Abbott v. Coe.* This avoidance of its **judicial functions** by the Court of Appeals, **has never been passed upon by this Court.**

In *General Motors v. Coe* (1941) 120 F. 2d 736, 737, the Court of Appeals for the District of Columbia refused to follow the **established law** in a suit under Section 4915 R. S., and judicially created a **different law** for the Courts of the District of Columbia, by following an erroneous decision, as follows—

> "But 'Whatever else may be said of the older decisions that, in appeals from the Patent Office, doubt was to be resolved in favor of the applicant, **they are obviously not law in relation to appeals from the District Court.** *Minnesota Mining Co. v. Coe,* App. D. C., 118 F. 2d 593, 594.' "

It is pertinent to note that Mr. Justice *Stephen* very properly **dissented** from the Minnesota decision; and it is

believed that such **judicial legislation** cannot affect, and should justify, a Writ of Certiorari here.

In *Williams Co. v. Shoe Mach. Corp.* (1942) 316 U. S. 364, 367, the concurrent findings below were very properly sustained because—

> "These findings are to the effect that the new **combinations, while they involve old mechanical** constructions, **combine** these in a **new way** so as to **produce an improved result.**
>
> "These are findings of fact, . . . and we will not disturb such concurrent findings where, as here, **there is evidence to support them.**"

That is exactly the **reverse** of the present situation, where there is **no evidence** to support the **concurrent findings.** However, the **undisputed additional evidence** of **invention** justifies a Writ of Certiorari, here, for the **first** reason quoted above from the *Williams* case.

In *United States v. Chemical Foundation* (1926) 272 U. S. 1, 14, the same rule was properly applied under similar circumstances; but as there were **no opinion, findings,** or **conclusions** below on the evidence submitted, the present case should be reviewed by this Court.

In *Washington Securities Co. v. United States* (1914) 234 U. S. 76, 78, the findings below were properly sustained, because—

> "The rule is well settled that findings of fact concurred in by two lower courts will not be disturbed by this Court unless shown to be clearly erroneous. . . .
>
> "Applying the rule to the evidence in this case, we think the findings below should not be disturbed."

Here, there were **no findings applied to the evidence submitted** to the District Court, and for that reason alone the decision below should be reviewed by this Court.

In *Thomson Co. v. Ford Motor Co.* (1924) 265 U. S. 445, this Court refused to apply the rule of "**concurrent findings of the lower courts on questions of fact**", because there

were **conflicting decisions** on the **particular subject** in different Circuit Courts of Appeals; which should justify a similar refusal here, and the granting of a Writ of Certiorari.

In *United States v. Esnault-Pelterie* (1936) 299 U. S. 201, the proceedings in the Court of Claims was dealt with as an **action at law** with a **special verdict**, in which **"the evidence is not brought up"** (p. 205), and was properly remanded for findings of fact, which is not the situation here.

In a subsequent consideration of the same suit in 1938, 303 U. S. 26 at page 30 it was very pertinently said *per curiam* that—

> "Where, **with all the evidence before the Court**, it appears that **no substantial dispute of fact** is presented, . . . the questions of **invention** and infringement **may be determined** as **questions of law.**"

That is exactly the situation here, which should justify a Writ of Certiorari.

In *Smith v. Hall* (1937) 301 U. S. 216 at page 233 it was very pertinently said by Mr. Justice *Stone* that, **"Commercial success may turn the scale when invention is in doubt"** which is indicated by the Board of Appeals to be the situation here (R. 153), and that fact should justify a Writ of Certiorari.

In *Textile Machine Works v. Hirsch Co.* (1938) 302 U. S. 490, at page 499, it was repeated by Mr. Justice *Stone* that—**"Commercial success may be decisive where invention is in doubt"**;—which should justify a Writ of Certiorari here.

In *Special Equipment v. Coe* (1945) 324 U. S. 370 at page 377 it was said by Mr. Chief Justice *Stone* that—

> "The statutes permit, and it is the settled practice of the Patent Office, many times sustained by this Court, to allow, claims to a combination and **also its sub-combinations.**"

It is futile to argue here that "*Sub-combination claims are not ipso facto allowable,*" because it has been shown at pages 2, 3 and 4, *supra,* that "**invention**" is present in the refused claims, in **addition** to the fact that they define something "**new and useful**".

This situation satisfies **all the requirements** of R. S. 4886, 35 U. S. C. 31, and entitles the Petitioners to receive a patent by a Writ from this Court.

In *Cuno Corp. v. Automatic Device Corp.* (1941) 314 U. S. 84, at page 91 it was said by Mr. Justice *Douglas* that—

> "The new device, however useful it may be, must reveal the flash of creative genius, not merely the skill of the calling. If it fails, it has not established its right to a private grant on the public domain."

The additional evidence of invention presented in the present proceeding to the trial Court, showing that Riemenschneider and Rastetter's **new device** solved an important and difficult problem and satisfied **a crying need,** and that the device was **novel in structure,** and functioned in a novel manner to produce a **new and unexpected result** not attainable by prior devices, is believed fully to satisfy the requirements of invention as expressed in the *Cuno* case.

Respectfully Submitted,

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Washington, D. C.
September 5-12, 1946.

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In the Supreme Court of the United States

OCTOBER TERM, 1946

No. 292

THE UNION METAL MANUFACTURING COMPANY, AND EDMUND W. RIEMENSCHNEIDER, AND MABEL ST. ELMO RASTETTER, EXECUTRIX OF HARRY O. RASTETTER, DECEASED, PETITIONERS

v.

CASPER W. OOMS, COMMISSIONER OF PATENTS

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE DISTRICT OF COLUMBIA

BRIEF FOR THE RESPONDENT IN OPPOSITION

OPINIONS BELOW

The findings of fact and conclusions of law of the United States District Court for the District of Columbia (R. 13–15) were entered without an opinion. The opinion of the United States Court of Appeals for the District of Columbia (R. 159–160) is reported in 154 F. 2d 857.

JURISDICTION

The judgment of the Court of Appeals was entered on April 15, 1946 (R. 161). The petition for a writ of certiorari was filed on July 12,

1946. The jurisdiction of this Court is invoked under Section 240 (a) of the Judicial Code, as amended by the Act of February 13, 1925.

QUESTION PRESENTED

Whether the courts below erred in upholding the rejection of petitioners' claims in the Patent Office on the ground that they do not disclose invention.

STATUTES INVOLVED

The statutes involved are set forth in the Appendix, *infra,* pp. 10–11.

STATEMENT

On November 8, 1944, petitioners brought this suit in the United States District Court for the District of Columbia, under R. S. 4915, 35 U. S. C. 63, *infra,* pp. 10–11, to obtain a judgment which would authorize respondent[1] to issue a patent containing claims 1 and 2[2] of application Serial No. 513,730, which was filed in the Patent Office on December 10, 1943, and which is a division of

---

[1] Respondents' predecessor as Commissioner of Patents was named as defendant in the complaint (R. 3). On August 27, 1945, however, respondent was substituted as defendant in lieu of his predecessor (R. 16).

[2] Claims 1 and 2 read as follows (R. 6–7, 14, 109, 123–124, 153, 159):

1. A longitudinal compression member having equal strength in all lateral directions comprising two elongated frusto-conical tubes in substantially straight axial alignment throughout their length with their large ends joined in abutment, and means at each end of said member for re-

application Serial No. 405,378, filed on August 4, 1941 (R. 2–13, 104). The claims relate, in general, to a longitudinal cylindrical tube, described as a "compression member", tapered toward each end (R. 6–7, 13–14, 104–112, 123–124, 153, 159). The tube thus described is useful as a member of an articulated radio antenna tower or as a ship boom (R. 13, 20–22, 25–30, 40–42, 68–72, 104–112, 116–118).

The Examiner rejected the claims as defining no invention over various prior cited patents (R. 119–120) and stated that lack of invention was so clear "that even outstanding commercial success * * * would not be enough to produce patentability" (R. 120).[3] On appeal (R. 121–

---

ceiving and transmitting compressive forces longitudinally through said member.

2. A longitudinal compression member having equal strength in all lateral directions comprising a central cylindrical tube and two elongated frusto-conical tubes in substantially straight axial alignment throughout their length and having their large ends joined in abutment with the ends of said cylindrical tube, and means at each end of said member for receiving and transmitting compressive forces longitudinally through said member.

[3] Petitioners state (Pet. 14) that the Examiner admitted "that some of his reasons for rejecting the pending claims were 'mere speculations' (R. 96)". It is to be noted (1) that the "admission" upon which petitioners rely is contained not in any decision with reference to the claims here in issue but rather in a Decision on Motions in an interference proceeding relating to the parent application, which Decision was rendered more than a month before the application here in issue was filed and (2) that the "admission" was not with reference to the examiner's finding that petitioners' claims had been anticipated by the prior art. (R. 92–96, 4–5.)

123), the decision of the Examiner was affirmed by the Board of Appeals in the Patent Office (R. 154). The Board noted that the Examiner was "not satisfied that the [commercial] success [of petitioners' device] is due to the inventive or unobvious nature of the construction" and found "that there is no doubt that the devices claimed are mere expedients when viewed in the light of the prior art" (R. 154).

After a trial (R. 17–40), the district court dismissed the complaint (R. 15–16), finding as facts that, in view of seven specified prior patents, petitioners' device disclosed no invention (R. 14–15), that "Neither of the claims in suit recites anything amounting to invention over the prior art", and that "Neither of the claims in suit is patentable" (R. 15). The court accordingly concluded that petitioners were "not entitled to receive a patent containing either of the claims in suit" (R. 15).

On appeal (R. 16–17), the court below affirmed the judgment of the district court (R. 160–161).

ARGUMENT

The court below held, *per curiam*, that "the novelty necessary to show inventive genius is lacking in these claims" and adopted the findings of fact of the district court to show that petitioners' "device had been anticipated" (R. 160). The court below held further that while petitioners had "proved the utility of their product as a cargo

boom, and its widespread acceptance by the shipping industry as a useful device", "a plain absence of invention is not overcome by evidence of usefulness and commercial success" (R. 160). The decision below is clearly correct in each of its aspects.

1. The device here involved is a simple one. It consists essentially of two elongated frusto-conical members, secured together at their bases or, alternatively, of a similar arrangement in which a cylindrical member is placed between the bases of the cones. From the decision of the Examiner in the Patent Office (R. 119–120), from the decision of the Patent Office Board of Appeals (R. 152–154), from the findings of fact of the district court (R. 13–15), and from the decision below (R. 159–160) which adopted those findings (R. 160), it is obvious that prior patents disclose structures which are similar to that of petitioners' device as defined in their claims, and that their device presents no inventive difference. The findings of the district court to this effect are, of course, not to be set aside unless clearly wrong (Rule 52 (a), F. R. C. P.; *Adamson* v. *Gilliland,* 242 U. S. 350; *Warren* v. *Keep,* 155 U. S. 265; *Magnaflux Corp.* v. *Coe,* 139 F. 2d 531 (App. D. C.); *General Motors Corp.* v. *Coe,* 120 F. 2d 736 (App. D. C.), certiorari denied, 314 U. S. 688, rehearing denied, 314 U. S. 715; *Hydraulic Press Corp.* v. *Coe,* 134 F. 2d 49 (App. D. C.)), particularly since they were concurred in by the court

below. *Williams Co.* v. *Shoe Mach. Corp.*, 316 U. S. 364, 367; *Page* v. *Arkansas Gas Corp.*, 286 U. S. 269, 271; *United States* v. *Commercial Credit Co.*, 286 U. S. 63, 67; *Texas & N. O. R. Co.* v. *Brotherhood of Railway Clerks*, 281 U. S. 548, 558; *I. T. S. Co.* v. *Essex Co.*, 272 U. S. 429, 433; *United States* v. *Chemical Foundation*, 272 U. S. 1, 14; *Washington Securities Co.* v. *United States*, 234 U. S. 76, 78. The conclusion that those findings are not erroneous is fortified by the fact that they are in agreement with the determination of the Examiner and the Board of Appeals in the Patent Office. See *Abbott* v. *Coe*, 109 F. 2d 449, 451–452 (App. D. C.). This Court will not ordinarily review issues of fact in cases of this character. *Keller* v. *Adams-Campbell Co.*, 264 U. S. 314, 319; cf. *Layne & Bowler Corp.* v. *Western Well Works, Inc.*, 261 U. S. 387; *General Talking Pictures Corp.* v. *Western Electric Co.*, 304 U. S. 175.[4]

[4] There is obviously no merit to petitioners' contention (Pet. 7–8, 20–25) that the findings of the district court (R. 13–15) were inadequate. In its findings, that court stated briefly what petitioners' application disclosed (R. 13), what the claims recited (R. 14), and what the patents which anticipated petitioners' device disclosed (R. 14). The district court then made findings that certain differences between petitioners' device and the structures shown by prior patents would not involve invention, and expressly found that neither of petitioners' claims recited "anything amounting to invention over the prior art" (R. 15). From these findings, the conclusion (R. 15) that petitioners were "not entitled to receive a patent containing either of the claims" necessarily followed.

Petitioners contend, however (Pet. 9–10, 26–27), that the question whether their device represents invention is one of law rather than of fact. It is well settled, of course, that whether an improvement in the arts constitutes invention is ordinarily a question of fact. *Thomson Co.* v. *Ford Motor Co.*, 265 U. S. 445; *United States* v. *Esnault-Pelterie*, 299 U. S. 201; *Keyes* v. *Grant*, 118 U. S. 25. But petitioners rely on decisions (Pet. 9, 26–27) which indicate that the question of invention may be one of law if a mere comparison of structures is involved and extrinsic evidence is not needed to explain them. However, it is clear that something more than a mere comparison of structures is here involved and, indeed, petitioners have relied heavily on extrinsic evidence (Pet. 7, 20–21). Moreover, even regarding the question of invention as one of law would not materially strengthen petitioners' position, for they have failed to show that the two courts below or the Examiner or Board of Appeals in the Patent Office erred in comparing the structure of petitioners' device with that of devices covered by the patents which the courts below found to have anticipated petitioners' (R. 14–15, 160).

2. While the court below found that petitioners had "proved the utility of their product as a cargo boom, and its widespread acceptance by the shipping industry as a useful device" (R. 160), it held (R. 160) that "commercial success does not supply the lacking invention." "Only when there

is doubt as to invention or novelty is proof of practical utility and general commercial acceptance permitted to turn the decision in favor of patentability" (R. 160). *McClain* v. *Ortmayer,* 141 U. S. 419; *Smith* v. *Hall,* 301 U. S. 216; *Textile Machine Works* v. *Hirsch Co.,* 302 U. S. 490; *Dow Co.* v. *Halliburton Co.,* 324 U. S. 320, 330. If it is clear that there is no invention, then no amount of commercial success can support a holding of patentability.

In this connection, petitioners contend that, in making its findings of fact, the district court erred in ignoring the evidence as to the commercial acceptability of their device (Pet. 5, 7, 20–21). However, there was no reason why findings as to commercial success should have been made. There was, in the first place, no dispute on this point. Moreover, since lack of invention was clear and conclusive, commercial success was immaterial and there was no occasion for making a finding with respect to it. In any event, petitioners were not prejudiced by any such lack in the findings since it is clear that, on appeal, the court below considered the commercial success of petitioners' device and accepted it as "proved" (R. 160).

3. Since the claims in issue are subcombination claims, petitioners assert that they are patentable under the decision of this Court in *Special Equipment Co.* v. *Coe,* 324 U. S. 370 (Pet. 5–6, 15–17). It is true that that case held that subcombination claims may be allowable. However, the present claims have not been rejected because they are

subcombination claims, but because they define no invention.[5] Subcombination claims are not *ipso facto* allowable. Like all others, they stand or fall on their own merits. The fact that claims define something which is "new and useful" is not enough; "invention" or "discovery" must also be present. R. S. 4886, 35 U. S. C. 31, *infra*, p. 10; *Cuno Corp.* v. *Automatic Devices Corp.*, 314 U. S. 84. Accordingly, the fact that petitioners' claims are subcombination claims is immaterial.

CONCLUSION

The decision of the court below is correct, no question of general importance is presented, and the controversy turns on questions of fact. The petition for a writ of certiorari should therefore be denied.

Respectfully submitted.

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AUGUST 1946.

[5] The Patent Office's rejection of the claims in the *Special Equipment* case was not based on prior art. 324 U. S. at 373.

APPENDIX

Section 4886 of the Revised Statutes (35 U. S. C. 31):

> Any person who has invented or discovered any new and useful art, machine, manufacture, or composition of matter, or any new and useful improvements thereof, or who has invented or discovered and asexually reproduced any distinct and new variety of plant, other than a tuber-propagated plant, not known or used by others in this country, before his invention or discovery thereof, and not patented or described in any printed publication in this or any foreign country, before his invention or discovery thereof, or more than one year prior to his application, and not in public use or on sale in this country for more than one year prior to his application, unless the same is proved to have been abandoned, may, upon payment of the fees required by law, and other due proceeding had, obtain a patent therefor.

Section 4915 of the Revised Statutes (35 U. S. C. 63):

> Whenever a patent on application is refused by the Board of Appeals or whenever any applicant is dissatisfied with the decision of the board of interference examiners, the applicant, unless appeal has been taken to the United States Court of Customs and Patent Appeals, and such appeal is pending or has been decided, in

which case no action may be brought under this section, may have remedy by bill in equity, if filed within six months after such refusal or decision; and the court having cognizance thereof, on notice to adverse parties and other due proceedings had, may adjudge that such applicant is entitled, according to law, to receive a patent for his invention, as specified in his claim or for any part thereof, as the facts in the case may appear. And such adjudication, if it be in favor of the right of the applicant, shall authorize the commissioner to issue such patent on the applicant filing in the Patent Office a copy of the adjudication and otherwise complying with the requirements of law. In all cases where there is no opposing party a copy of the bill shall be served on the commissioner; and all the expenses of the proceedings shall be paid by the applicant, whether the final decision is in his favor or not. In all suits brought hereunder where there are adverse parties the record in the Patent Office shall be admitted in whole or in part, on motion of either party, subject to such terms and conditions as to costs, expenses, and the further cross-examination of the witnesses as the court may impose, without prejudice, however, to the right of the parties to take further testimony. The testimony and exhibits, or parts thereof, of the record in the Patent Office when admitted shall have the same force and effect as if originally taken and produced in the suit.

U. S. GOVERNMENT PRINTING OFFICE: 1946

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In the Supreme Court of the United States

OCTOBER TERM, 1946.

No. 292.

THE UNION METAL MANUFACTURING COMPANY,
and
EDMUND W. RIEMENSCHNEIDER, and
MABEL ST. ELMO RASTETTER,
Executrix of Harry O. Rastetter, Deceased,
Petitioners,

vs.

CASPER W. OOMS,
as Commissioner of Patents,
Respondent.

PETITION FOR REHEARING.

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Washington, D. C.,
November 6, 1946.

THE GATES LEGAL PUBLISHING CO., CLEVELAND, OHIO—MAIN 5647

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The Trends in Federal Law and Procedure, Paper by United States District Judge Grover M. Moscowitz, 5 F. R. D. 361..... 2, 3

Decided Cases.

Fletcher v. Peck (1810) 6 Cranch 87..... 6

Goodyear v. Ray-O-Vac (1944) 321 U. S. 275..... 6

Interstate Circuit v. United States (1938) 304 U. S. 55 6

Kelley v. Everglades (1943) 319 U. S. 415..... 6

Market Street v. Rowley (1895) 155 U. S. 621..... 6

Mayo v. Canning Co. (1940) 309 U. S. 310..... 6

Railroad Company v. DuBois (1870) 12 Wall. 47..... 5

Special Equipment v. Coe (1945) 324 U. S. 370..... 5

United States v. Esnault-Pelterie (1938) 303 U. S. 26.. 6

Statute.

35 U. S. C., Sec. 63 5

Rules of Civil Procedure.

Rule 52(a) 6

In the Supreme Court of the United States

OCTOBER TERM, 1946.

No. 292.

THE UNION METAL MANUFACTURING COMPANY,
and
EDMUND W. RIEMENSCHNEIDER, and
MABEL ST. ELMO RASTETTER,
Executrix of Harry O. Rastetter, Deceased,
Petitioners,

vs.

CASPER W. OOMS,
as Commissioner of Patents,
Respondent.

PETITION FOR REHEARING.

Come now the above-named petitioners, and present this their Petition for a Rehearing of the Petition for Certiorari in this case.

I.

JURISDICTION.

The Petition for Certiorari was filed on July 12, 1946; and was denied on October 14, 1946. This petition is filed within less than twenty-five days thereafter, under Rule 33 of this Court.

II.

REASONS FOR PETITION FOR REHEARING.

1. The ultimate error in the decision of the Court of Appeals below, is that it constitutes judicial legislation and is based on judge-made law, the evil effects of which are set forth in *The Imperiled Position of Our Patent System,* a judicial Address by United States District Judge

Clarence G. Galston before the Association of the Bar of the City of New York on May 14, 1945. 149 F. 2d xxiii.*

2. *The Trends in Federal Law and Procedure,* a judicial Paper by United States District Judge Grover M. Moscowitz, 5 F. R. D. 361,* points out the public importance of properly constraining erroneous judicial legislation and judge-made law by lower courts, by compelling decisions of the Supreme Court.

III.

Re JUDICIAL LEGISLATION.

1. The ultimate error of the Court below was in deciding each one of the questions presented below, by judicial legislation, in a manner contrary to relatively recent decisions of this Court, and without the support of any pertinent decision by any other one of the United States Circuit Courts of Appeals.

2. In seeking to justify proper judicial legislation, Judge Galston says that—

> "Lower courts are, of course, constrained by the compelling decisions of the United States Supreme Court." (p. XXIV)

The Court below was not so constrained, because the judge-made law on each one of the questions presented, was neither dependent on nor established by any decision of this Court.

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* Judge Galston's Address was published only in the advance sheets of 149 F. 2d XXIII, which were not preserved by counsel for the petitioners; and did not come to their attention until reading Judge Moscowitz's Paper; whereupon a copy of the Address was obtained from the West Publishing Company on October 21, 1946, one week after the Petition for Certiorari was dismissed, and was then read for the first time by Counsel for Petitioners. A copy of the Address obtained from Honorable Eugene J. Keogh, a member of Congress from New York City who is Chairman of the House Committee on Revision of the Laws, is submitted herewith.

IV.

Re JUDICIAL USURPATION.

1. The errors below are something more than mere judicial legislation. They amount to judicial usurpation with respect to each one of the questions presented, and are all decided in defiance of controlling decisions of this Court.

2. If judicial legislation by lower Courts imperils our patent system and should be constrained by compelling decisions of this Court, the patent system is even more imperiled by judicial usurpation in lower Courts and must be absolutely prevented by positive action in this Court, if our patent system is to be preserved.

V.

CONSTITUTIONAL PROVISIONS.

1. It is well said by Judge Galston that—

> "It cannot be gainsaid that the framers of the Constitution had no pre-vision of the giant industrial corporations of the present age, nor of the research laboratories which wise administration and foresight by their management created.
>
> "But other clauses of the Constitution have yielded to changed economic conditions. Why should difficulty be encountered in a liberal interpretation of the Constitutional clause respecting inventions?
>
> "The promotion of the 'progress of science and useful arts' was the primary object of the Constitutional provision. The reward to the inventor was but a secondary consideration.
>
> "Progress in the arts and sciences was the all important aim—the reward only the means suggested." (p. XXIX)

2. To the same effect it is said by Judge Moscowitz that—

> "Our industrialization has progressed rapidly under a system which encourages competitive research and invention by affording relative assurance of compensation for successful creative effort.

"Those who argue that invention would continue although the reward be removed are overlooking human experience; the greater the protection afforded an inventor, the greater will be his endeavors." (p. 376)

VI.

PUBLIC IMPORTANCE OF THE ERRORS.

1. A call upon this Court for affirmative action is made by Judge Galston, as follows—

"Progress of industry under patent protection is generally conceded.

"Now a changing judicial attitude suggests the need of thorough exploration of underlying conditions affecting the issuance and the use of letters-patent if the aim of the Constitution is to be preserved." (p. XXIV)

2. In conclusion, it is pointed out by Judge Galston that—

"If the objective of the Constitutional provision is to be attained, it would seem the path of expediency and of necessity to aid rather than to obstruct invention.

"There has been ample testimony throughout the years by eminent commentators that without the proffer of patent protection it would have been impossible to create, or maintain after creation, a great number of the industries which marked the progress of the United States in the application of science to human needs.

"Nor can anyone fail to realize our critical dependence in this war upon the inventions that were developed in peace time as well as during the progress of the war.

"Of necessity too, post-war planning must contemplate encouragement to initiate industries, as well as to carry on the old, by holding out the awards which a sound patent system should promote." (pp. XXX, XXXI)

3. The conclusions of Judge Galston have a direct bearing on the petitioner's improvement, which not only founded a new industry, but as pointed out in the Reply Brief in Support of Petition—

> "During the recent World War II there were many crying needs which had to be satisfied if the prosecution of the war was to be successful.
>
> "The genius of Americans and American Industry satisfied those needs and solved the problems existing.
>
> "The steps taken by Riemenschneider and Rastetter in solving the problem of handling cargo by ship booms, created by the need of transporting locomotives, tractors and tanks, aeroplanes and jeeps, and heavy war material of every description, across the seven seas to the four corners of the earth, is but one example of the exercise of such genius." (Reply Brief, p. 3)

VII.

THE IMPERILED POSITION APPLIED.

In a single decision affirming the District Court, the Court below jumped over all the barriers which have been built around the patent statutes by this Court for preserving the ultimate purpose of the Constitution, which is to promote the development of the arts and sciences; and in so doing the Court below arbitrarily usurped the exclusive prerogative of this Court to overrule or modify its own previous decisions.

1. (a) Both Courts below actually annulled several decisions of this Court in denying patentability to sub-combination claims after inclusive combination claims were allowed; such denial being directly contrary to the rule of decision established by this Court in *Railroad Company v. DuBois* (1870) 12 Wall. 47, 60, and *Special Equipment v. Coe* (1945) 324 U. S. 370, 376 (Petition for Certiorari, pp. 15, 16).

(b) The denial of sub-combination claims was also contrary to an express provision in Title 35, Section 63,

United States Code, under which the action was brought (Id. 17).

2. (a) Both Courts below erroneously failed to follow the law established by this Court in refusing a patent upon evasive findings and conclusions. See *Fletcher v. Peck* (1810) 6 Cranch 87, 147, and *Mayo v. Canning Co.* (1940) 309 U. S. 310, 316 (Id. 19).

(b) Both Courts below also ignored the twelve undisputed facts specified in the Petition for Certiorari (p. 21); and its denial of invention in the pending claims is a refusal to follow the rule of this Court in *Goodyear v. Ray-O-Vac* (1944) 321 U. S. 275, 279 (Id. 22).

3. Both Courts below erroneously refused to follow the rule of this Court, in failing to find the facts specially and to state conclusions of law separately on all the issues that the case presents; as required by Rule 52(a) of Civil Procedure, interpreted in *Interstate Circuit v. United States* (1938) 304 U. S. 55, 56, and in *Kelley v. Everglades* (1943) 319 U. S. 415, 420 (Id. 24).

4. Both Courts below, in effect, overruled this Court in denying invention upon several prior patents as a matter of fact, when "*no extrinsic evidence was given or needed to explain terms of art*"; contrary to the rule of this Court that in such a situation the question of invention is a matter of law, as established by *Market Street v. Rowley* (1895) 155 U. S. 621, 625, and *United States v. Esnault-Pelterie* (1938) 303 U. S. 26, 30 (Id. 27).

The single decision of the Court below constitutes judicial legislation, because the Court has either annulled, or has refused to follow, or has in effect overruled controlling decisions of this Court on each one of the four questions presented to the lower Court.

VIII.

For the foregoing reasons, your petitioners respectfully urge that a rehearing be granted; that upon further consideration the order of October 14, 1946 denying the petition for certiorari be revoked; and that the writ of certiorari issue.

HARRY FREASE,
EDWARD R. WALTON, JR.,
Counsel for Petitioners.

EVERETT R. HAMILTON,
JOSEPH FREASE,
Of Counsel.

Washington, D. C.,
November 6, 1946.

We, Harry Frease and Edward R. Walton, Jr., counsel for the above named petitioners, The Union Metal Manufacturing Company, and Edmund W. Riemenschneider and Mabel St. Elmo Rastetter, Executrix of Harry O. Rastetter, Deceased, do hereby certify that the foregoing petition for a rehearing of this cause is presented in good faith and not for delay.

HARRY FREASE,
EDWARD R. WALTON, JR.,
Counsel for Petitioners.